

Doc Code: AP.PRE.REQ

PTO/SB/93 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) TN-3305	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>January 30, 2006</u> Signature <u>Delrose S. Lumsden</u> Typed or printed Name <u>Delrose S. Lumsden</u>		Application Number 10/688,668	Filed October 17, 2003
First Named Inventor Gregg L. Shaddy et. al.		Art Unit 3724	
Examiner Blake, C.			

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
 Note: No more than five (5) pages may be provided.

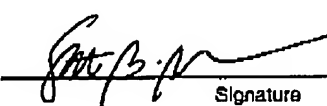
I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
 See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
 (Form PTO/SB/96)

☒ attorney or agent of record.
 Registration number 48,899

☐ attorney or agent acting under 37 CFR 1.34.
 Registration number _____


 Signature

Scott B. Markow Esq.
 Typed or printed name

410-716-3608
 Telephone number

January 30, 2006
 Date

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Gregg L. Sheddy et al.
Serial No. : 10/688,668
Filed : October 17, 2003
Title : TILE SAW

Art Unit : 3724
Examiner : Blake, C.

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
CENTRAL FAX CENTER
JAN 30 2006

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

This is in response to the final Office Action mailed October 28, 2005 and the Advisory Action mailed January 18, 2006. A Notice of Appeal has been filed herewith.

Claims 1-5 are pending with claim 1 being independent.

Claims 1-4 have been rejected under 35 U.S.C. § 103(a) as being obvious over Lee (U.S. Pat. No. 6,272,961). For at least the following reasons, Applicants respectfully request withdrawal of this rejection.

Claim 1 relates to a saw and recites, among other things, a "motor assembly pivotably supported by [a] support assembly," and "a switch electrically connected to the motor assembly and disposed on the support assembly so that, when the motor assembly is pivoted about the pivot axis, the switch remains stationary." Lee fails to describe or suggest at least two features of claim 1: (1) a switch that is "disposed on the support assembly," and (2) that the switch "remains stationary" "when the motor assembly is pivoted about the pivot axis."

Lee describes a cutting machine having a cutting head support bracket 23 (which the Examiner equates to the claimed support assembly) that supports a cutting head 40. Cutting head 40 includes a motor 41 (which the Examiner equates to the claimed motor assembly), a saw blade 42, and a transmission means 43 that transmits power from the motor 41 to rotate the saw blade 42. Mounted to the cutting head 40 is a controlling head 45 that includes a controlling switch (which the Examiner equates to the claimed switch).

First, Lee fails to describe the switch being "disposed on the support assembly," as recited in claim 1. Rather, in Lee the controlling switch is disposed on the cutting head 40. The cutting head 40 of Lee cannot be considered part of the claimed support assembly because the cutting

Applicant : Gregg L. Shetty
Serial No. : 10/688,668
Filed : October 17, 2003
Page : 2 of 3

Attorney's Docket No.: TN-3305

head 40 has been equated by the Examiner to the claimed motor assembly as pivoting about a pivot axis relative to the support assembly. Because the switch of Lee is disposed on the cutting head 40 that pivots relative to the support bracket 23, it is not "disposed on the support assembly," as recited in claim 1.

Second, as acknowledged on pages 2-3 of the Office Action, Lee fails to describe that the switch "remains stationary" "when the motor assembly is pivoted about the pivot axis." The Office Action asserts that it would have been obvious "to provide the switch [of Lee] in an alternative location since it has been held the shifting of parts to different positions is a known variable." Office Action at page 3 (citing In re Japiske, 86 U.S.P.Q. 70 (C.C.P.A. 1960)). However, "[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." M.P.E.P. § 2144.04(IV)(C) (quoting Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)).

Applicants respectfully submit that Lee fails to provide any motivation or suggestion for making the proposed modification to the position of the switch of Lee. To the contrary, Lee teaches the switch being located on the controlling head 45 to control the electrical controlling means, including the circuit control and fuse, which are used to control the motor 41. Lee at col. 4, lines 17-23. Lee provides no motivation or suggestion for placing the switch at a stationary location. Absent the use of impermissible hindsight, there is no suggestion or motivation to move the location of the switch of Lee.

In the Advisory Action, the Examiner states that changing the location of the switch would have been obvious because the location of the switch does not appear to be critical. However, as mentioned in Applicants' initial response to the Final Rejection, having the switch remain stationary, as recited in claim 1, provides significant advantages over the moveable switch shown in Lee. For example, the stationary switch allows the user of the tile saw to know

Applicant : Gregg L. Shetty
Serial No. : 10/688,668
Filed : October 17, 2003
Page : 3 of 3

Attorney's Docket No.: TN-3305

the location of the switch at all times during operation of the device. This provides a safety feature when the user must quickly shut off the device during use.

For at least the foregoing reasons, Lee does not form a prima facie case of obviousness against claim 1. Accordingly, the rejection of claim 1, and its dependent claims 2-4, should be withdrawn.

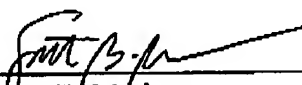
Claim 5 has been rejected under 35 U.S.C. § 103(a) as being obvious over Lee in view of Klingens (U.S. Pat. No. 2,691,398). Claim 5 depends from claim 1 and is allowable for at least the reasons discussed above with respect to claim 1. Moreover, Klingens does not remedy the deficiencies of Lee discussed above with respect to claim 1. In particular, Klingens does not describe or suggest, nor is it relied upon to show, at least the claimed "switch electrically connected to the motor assembly and disposed on the support assembly so that, when the motor assembly is pivoted about the pivot axis, the switch remains stationary." For at least these reasons, claim 5 is patentable over Lee and Klingens.

In view of the foregoing, Claims 1-5 are patentable over the art of record and the application is believed to be in condition for allowance.

Enclosed is authorization to charge \$500.00 to deposit account 02-2548 for the Notice of Appeal. Please apply any other charges or credits to deposit account 02-2548.

Respectfully submitted,

Date: Jan. 30, 2006



Scott B. Markow
Reg. No. 46,899

The Black & Decker Corporation
701 E. Joppa Road - TW199
Towson, MD 21286
Telephone No.: (410) 716-3606
Facsimile No.: (410) 716-2610